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| APPLICATION NO.                | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/725,659                     | 12/02/2003  | Karin Golz-Berner    | 4034.003            | 5041             |
| 30448                          | 7590        | 11/13/2008           |                     |                  |
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| EXAMINER                       |             |                      |                     |                  |
| CHONG, YONG SOO                |             |                      |                     |                  |
| ART UNIT                       |             | PAPER NUMBER         |                     |                  |
| 1617                           |             |                      |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/725,659

**Applicant(s)**

GOLZ-BERNER ET AL.

**Examiner**

YONG S. CHONG

**Art Unit**

1617

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 12-16, 18, 19 and 23-30 is/are pending in the application.
- 4a) Of the above claim(s) 15 and 26-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-14, 16, 18, 19, 23-25, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of the Application***

This Office Action is in response to applicant's response filed on 8/21/2008. Applicant's election **with** traverse of the restriction requirement in the reply is acknowledged. The traversal is on the ground(s) that a species election is improper since four Office Actions have already been issued in the application. This is not found persuasive because Applicant has changed the scope of the invention through amendments to the claims. Applicant is reminded that this species requirement is just for search purposes. The requirement is still deemed proper and is therefore made FINAL.

Claims 24-30 are new. Claims 12-16, 18-19, 23-30 are pending. Claims 12 and 18 have been amended. Claim 15 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Claims 26-28 are withdrawn from further consideration as being drawn to a non-elected species. Claims 12-14, 16, 18-19, 23-25, 29-30 are examined herein insofar as they read on the elected invention and species.

Applicant's arguments regarding the provisional obviousness-type double patenting rejections of the last Office Action are persuasive. Accordingly, all provisional obviousness-type double patenting rejections of the last Office Action are hereby withdrawn.

Applicant's arguments regarding the 103(a) rejection of the last Office Action have been fully considered but found not persuasive. The rejection is maintained and modified below as a result of the new claim amendments.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham vs John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim(s) 12, 13 (in part), 14, 16, 18-19, 23-25, 29-30 are rejected under 35 U.S.C. 103(a) as being obvious over Nakane et al. (US Patent 5,122,418) in view of Konikoff (US Patent 4,142,521).

The instant claims are directed to a cosmetic composition comprising polymerized fluorocarbons, in the electret state, and Vitamin A.

Nakane discloses a composite cosmetic powder used for the skin (abstract). The resin powder is preferably Teflon with an average particle size of 1 to 100 microns (col. 10, lines 23-30). Essential oils, water, and other components usually used in cosmetics may be added (sentence bridging col. 10-11). Additional components include vitamin A, various alcohols and oils, which can be used in an amount 0.1 to 60% by weight (col. 11, line 29 to col. 12, line 1). Example 7 and 23 discloses Vitamin E at 0.05 weight percent. Example 28 also discloses a cosmetic stick composition for sunburn comprising Teflon powder in an amount of 10%.

However, Nakane et al. fail to disclose specifically the electret state of Teflon.

Konikoff teach the enhancement of soft tissue wound repair by electret-type materials, specifically the application of small electrical currents or weak magnetic or electrical fields. Such wounds include surgical incisions, abrasions, cuts, punctures, blemishes, tears, sores, blisters, burns, contusions, tissue ruptures, and the like (col. 1, lines 1-21). Konikoff also disclose that Teflon is a common material that can be made into electrets (col. 5, lines 25-36).

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to have substituted the electret state of Teflon as disclosed by Konikoff with the non-electret Teflon in the cosmetic composition disclosed by Nakane.

A person of ordinary skill in the art would have been motivated to make this substitution because: (1) both Nakane and Konikoff is concerned with the field of dermatology, particularly treatment of the skin; (2) Nakane discloses a cosmetic

composition comprising Teflon; (3) Konikoff discloses that Teflon is a electret material, which can enhance the skin by repairing skin blemishes, etc.; (4) therefore, the skilled artisan would have had a reasonable expectation of success in producing a cosmetic composition comprising electret Teflon for the skin.

Examiner notes that the limitations regarding the field strength and coercive force of the permanent electric dipole moment are considered inherent since a composition and its properties are inseparable.

"Products of identical chemical composition can not have mutual exclusive properties." Any properties exhibited by or benefits from are not given any patentable weight over the prior art provided the composition is inherent. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the disclosed properties are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to the applicant to show that the prior art product does not inherently possess the same properties as the instantly claimed product.

It is also noted that limitations regarding the process set forth in claims 23 and 30 are given little patentable weight since it is a product by process claim. It is respectfully pointed out that even though product-by-process claims are limited by and defined by the process; determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

*In re Thorp*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). "The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983).

### ***Response to Arguments***

Applicant makes the point that the improved absorption of cosmetically active ingredients was a surprising result to the Applicants and is not disclosed or suggested by any of the cited prior art references, whether alone or in combination. Applicant continues to explain how this is beneficial to the structurally complex, relatively thick membrane of the skin.

This is not persuasive because Applicant is reminded that the instant invention is drawn to a composition and not method claims. Therefore, the intended use or preamble of the composition will be given little patentable weight.

It is respectfully pointed out that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish from each other. If the prior art structure is

capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Thus, the intended use of a composition claim will be given no patentable weight.

It is further respectfully pointed out that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). See MPEP 2111.02.

Applicant argues that even where exudates are not present, Konikoff requires the use of a separate ground strip to complete the circuit. Thus, there is no disclosure or suggestion in Konikoff that using an electret without a ground strip would be of any benefit to wound healing or that using a polymeric electret that is not coated with a metallic foil would be of any benefit to wound healing.

This is not persuasive because the instant claims do not preclude the use of separate ground strip in the claimed composition. This is due to the fact that the claims use the open transitional language "comprising." Nonetheless, the Konikoff reference was merely used to modify the Teflon already disclosed in the primary reference, Nakane, into its electret state. The motivation coming from the Konikoff reference in that using an electrostatic field derived from an electret can promote healing of the soft



tissue. Thus, Konikoff is merely used to show that the electret state of Teflon is known to be used for promoting wound repair in soft tissue.

Applicant's arguments regarding creatine and Vitamin E are moot, since the elected species, Vitamin A, is disclosed by Nakane in the claimed amount range. It is also noted that Nakane discloses Teflon in the claimed amount range as evidenced in Example 28, where Teflon is present in the amount of 10%. Nonetheless, Examiner asserts that optimizing the amounts of the active agents in the claimed composition is well within the boundaries of one of ordinary skill in the art. It is Applicant's burden to show that the claimed range is critical to the instant invention.

Generally, mere optimization of ranges will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "When the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimal or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955); "The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages." *In re Peterson*, 315 F. 3d at 1330, 65 USPQ 2d at 1382; It has been held that it is within the skills in the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect. *In re Boesch*, 205 USPQ 215 (CCPA 1980) MPEP 2114.04

Applicant continues to insist that there was no known benefit of electret treatment of the intact skin, let alone that any disclosure or suggestion that the amounts of powder and active agents could improve absorption.

This is not persuasive because Konikoff teaches, in general, soft tissue wound repair by utilizing an electrostatic field derived from an electret, for example Teflon. Applicant is reminded that Konikoff defines "wound" to include surgical incisions, abrasions, cuts, punctures, blemishes, tears, sores, blisters, burns, contusions, tissue ruptures, and the like (col. 1, lines 12-15), some of which is characterized by intact skin.

Applicant argues that Konikoff teaches against the use of small spherical particles, as disclosed by Nakane, in bandages since they must be self-contained. Applicant also argues nonobviousness since Konikoff deals with wound care devices to which Nakane has no relevance to. Therefore, there is no motivation to one skilled in the art to combine electret materials with active ingredients to provide improved absorption.

This is not persuasive because Applicant has misinterpreted the obviousness rejection. The rejection does not state the use or modification of Konikoff's wound care devices. Applicant is reminded that it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to have substituted the electret state of Teflon as disclosed by Konikoff with the non-electret Teflon in the cosmetic composition disclosed by Nakane. The motivation used in the obviousness rejection does not have to align with that of the Applicants since the claims are drawn to a composition. The motivation exists because both Nakane and Konikoff

are concerned with the field of dermatology, particularly treatment of the skin. Nakane discloses a cosmetic composition comprising Teflon, and Konikoff discloses that Teflon is an electret material, which can enhance the skin by repairing skin blemishes, etc.

Finally, Applicant argues that although Konikoff discloses that it is known that small electric currents improve wound repair, it states that the reason for this "remains unclear." Because the mechanism is unknown, a person of skill in the art would not be able to predict whether small electronic currents would impact absorption of active ingredients or, for that matter, anything other than skin healing.

This is not persuasive because whether or not, the exact mechanism of wound repair through small electric currents is known, matters little to the fact that Konikoff teaches electrets improve wound healing. The assertion that the skilled artisan would not be able to predict whether small electronic currents would impact absorption of active ingredients for anything other than skin healing is irrelevant since the claims are drawn to a composition and not methods of improving the absorption of active ingredients in the skin or anything else.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong S. Chong whose telephone number is (571)-272-8513. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SREENI PADMANABHAN can be reached on (571)-272-0629. The fax

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phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Yong S Chong/  
Examiner, Art Unit 1617

YSC